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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GERARD PALLIPURAM and SUDHIR KULKARNI

Appeal 2008-0460
Application 09/826,733
Technology Center 2100

Decided: September 23, 2008

Before HOWARD B. BLANKENSHIP, ALLEN R. MACDONALD, and
CAROLYN D. THOMAS, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-10 and 27-40, which are all the claims remaining in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse, and enter a new ground of rejection as permitted by 37 C.F.R. § 41.50(b).

Appellants' invention is directed to a method and system for performing one-to-many synchronization using a central server and downloadable client software. (Abstract.) Claim 1 is illustrative.

1. A communication system comprising:

a server device comprising a database and client software, said database comprising information and said client software comprising instructions for performing a data synchronization compliant with said server; and

a first client device for performing data processing functions, said first client device for establishing a communication link with said server, for receiving a copy of said client software from said server in response to said communication link being established, and for using the copy of said client software to perform the data synchronization with said server to obtain a portion of said information, wherein:

as a result of performing the data synchronization, the portion of the information on the first client device and in the database of the server are up-to-date.

The Examiner relies on the following references as evidence of unpatentability.

Hebel	US 6,073,177	Jun. 6, 2000
Carini	US 6,636,873 B1	Oct. 21, 2003
		(filed Apr. 17, 2000)

Claims 1-9 and 27-39 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Hebel.

Claims 10 and 40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hebel and Carini.

I. The Standing Rejections

Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984). “[A]bsence from the reference of any claimed element negates anticipation.” *Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 1571 (Fed. Cir. 1986).

In the statement of rejection of claim 1, the Examiner provides details with respect to how the claim is deemed to read on Hebel (Ans. 4-5), but none (*see id.* at 7, 8-9) with respect to how the other independent claims on appeal are thought to be anticipated. Further, Appellants argue claim 1 as representative of the claims subject to the rejection for anticipation over Hebel. Accordingly, we will consider claim 1 as the representative claim in our review of the rejection of claims 1-9 and 27-39.

Appellants contend that Hebel fails to disclose a first client device for receiving a copy of the client software (comprising instructions for performing a data synchronization compliant with the server) in response to the communication link between the client device and the server, and for using the copy of the client software to perform the data synchronization with the server to obtain a portion of the information (from the database of the server). (App. Br. 7-11.)

Hebel describes a “dynamic data synchronization network” whereby a plurality of workstations 11 (Fig. 2) are coupled to a common server 13 using a network 15. The server 13 stores a master of a design model, providing a copy to the workstations 11 for review and update. Hebel Abstract. The server database 13a (Fig. 2) stores the master copy of the

model generated at the client workstations 11, and the workstations store a working copy. Each database in the system 10 comprises several individual files. The user must first establish a connection to the network file system to access a saved database. In a shared mode, users may share the same copy of the database. Hebel col. 4, ll. 6-17.

All database access and updates done by the client workstations 11 (Fig. 2) are through the database engine 11A and 13A. The database engine “on top of the database” is a common piece of software used by all client workstations and the server. As shown in Figures 6A and 6B, after initializing the TCP/IP communications, the server 13 reads the saved database and makes a copy local to the machine executing the server, which is called the “server working database.” Only the database engine executed by the server 13 references this server working database. Hebel col. 6, ll. 32-46.

When a client workstation 11 (Fig. 2) requests a connection to the server 13, server 13 writes its working database to the network file system. This copy of the project database is called the “synchronized database” (Fig. 6B), which is written only if it does not yet exist or is older than the current server working database. The server responds to the client workstation so that it may read the database and complete the connection and initialization. The client workstation 11, upon reading the synchronized database, creates a local copy to the machine executing the client (Fig. 6A). The local copy is called the “client working database,” which is referenced exclusively by the database engine executed by client workstation 11. Hebel col. 6, ll. 47-67.

The rejection contends (Ans. 11) that Hebel describes, in the above-noted sections, using a received copy of client software to perform a data

synchronization with the server to obtain a portion of information from the database. The rejection neglects to identify what this “received copy of client software” may be. Appellants speculate (Reply Br. 3) that the rejection may deem the described database engine to correspond to the claimed software. However, we do not find description in Hebel that any part of a database engine is transferred from the server to a client, much less in response to the communication link being established, as claimed. Nor do we find description of other elements that might serve to meet all the terms of instant claim 1.

Thus, at least for the reason that the rejection fails to map all elements of claim 1 to the reference, or otherwise account for all the language of the claim, we conclude that the Examiner has not set forth a prima facie case for anticipation of claims 1-9 and 27-39. We do not sustain the § 102 rejection of those claims. Nor can we sustain the § 103(a) rejection of claims 10 and 40, because Carini as applied does not remedy the deficiencies in the rejection against the base claims.

II. New Ground of Rejection -- 35 U.S.C. § 112, second paragraph

We reject claims 34-40 under 35 U.S.C. § 112, second paragraph, as being indefinite.

The function of claims is (1) to point out what the invention is in such a way as to distinguish it from the prior art; and (2) to define the scope of protection afforded by the patent. *In re Vamco Machine & Tool, Inc.*, 752 F.2d 1564, 1577 n.5 (Fed. Cir. 1985). The legal standard for definiteness is whether a claim reasonably apprises those of skill in the art of its scope. *In re Warmerdam*, 33 F.3d 1354, 1361 (Fed. Cir. 1994). The inquiry is merely

to determine whether the claims do, in fact, set out and circumscribe a particular area with a reasonable degree of precision and particularity. *In re Moore*, 439 F.2d 1232, 1235. The definiteness of the language employed must be analyzed -- not in a vacuum, but in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. *Id.*

Claim 34 recites a “medium” having instructions for establishing a communication link with “a device,” and instructions for downloading a copy of client software “from a database” to the device. Appellants disclose (e.g., Fig. 7) and claim (e.g., claim 1) a server having a database and client software, the client software being downloaded to a client device.

Appellants do not disclose instructions for downloading a copy of client software from “a database” to a device. Nor can we conjecture how such an instruction might be effected.

Claim 34 recites “instructions for establishing a communication link with a device.” According to Appellants’ Summary of Claimed Subject Matter (App. Br. 4), the instructions, when executed, are resident on the “device.” The claim also recites “instructions for responding to communications from the device when the device is executing [instructions].” Appellants’ Summary (App. Br. 4) makes no attempt to point to text or drawings in support of these claimed “instructions for responding.”

The “instructions for responding to communications from the device” must be instructions on some other “device,” such as a server, different from the claimed “device.” However, the preamble of claim 34 purports a medium having recorded thereon a plurality of instructions for “at least one”

processor, which includes exactly one processor. We are left to speculate how instructions for a single processor can effect operations on two separate devices, and further whether the claim requires some kind of “medium” that resides on separate devices.¹

Claims 35 through 40 incorporate the indefinite subject matter of claim 34, and thus also fail to pass muster under § 112, second paragraph. We note further, however, that whatever the “medium” is, claim 36 requires that it be capable of “displaying.” Also, the recitations of “the first device” and “the second device” in claim 40 lack proper antecedent basis. Even if antecedents were to exist, it is unclear how naming “devices” might serve to further limit whatever the “medium” of claim 34 may be.

CONCLUSION

The rejection of claims 1-9 and 27-39 under 35 U.S.C. § 102(e) as being anticipated by Hebel is reversed.

The rejection of claims 10 and 40 under 35 U.S.C. § 103(a) as being unpatentable over Hebel and Carini is reversed.

In a new ground of rejection, we reject claims 34-40 under 35 U.S.C. § 112, second paragraph, as being indefinite.

¹ A carrier wave medium might be distributed over a network, but signals embodied in carrier waves are not statutory subject matter. *See In re Nuijten*, 500 F.3d 1346, 1357 (Fed. Cir. 2007). “If a claim covers material not found in any of the four statutory categories, that claim falls outside the plainly expressed scope of § 101 even if the subject matter is otherwise new and useful.” *Id.* at 1354.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (2007). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

REVERSED -- 37 C.F.R. § 41.50(b)

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